

Application Serial No.: 09/891,806  
Amdt. Dated January 26, 2004  
Reply to Office Action of September 29, 2003

### **REMARKS**

The Office Action dated September 29, 2003 and the references cited therein have been carefully considered. In response to the Office Action, Applicants have cancelled Claims 4 and 11 and have amended Claims 1, 5, 8, 12, 15, 16, 18 and 19, which, when considered with the remarks set forth below, are deemed to place the case in condition for allowance. As a result of the present Amendment, Claims 1-20 remain in the case for continued prosecution.

In the Office Action, Claims 16 and 19 have been deemed allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants thank the Examiner for his indication of allowable subject matter. In response, Applicants have amended Claims 16 and 19 by rewriting the claims in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Claims 16 and 19 are now in condition for allowance.

Claims 1 and 3-6, however, have been rejected under 35 U.S.C. § 102(a) as being anticipated by the Nail Max 2000 magazine cited by Applicants in a prior Information Disclosure Statement. Specifically, the Examiner states that on Page 81 of the Nail Max 2000 magazine a "Sparkled White French Nail" having a clear bed portion and an opaque tip portion is disclosed.

Also in the Office Action, Claims 1, 3, 7, 8 10, 14 and 18 have also been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,751,935 to Mast et al. The Examiner states that the Mast et al. patent discloses an artificial nail and an artificial nail tip including a transparent bed portion and an opaque tip portion separated by a dividing line that corresponds to the natural nail transition line.

Claims 2 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Mast et al. patent in view of U.S. Patent No. D 380,867 to Agee, II et al. The

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Examiner states that the Agee, II et al. design patent shows dividing lines disposed at angles relative to the natural dividing line.

Claims 8 and 10-13 have also been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nail Max 2000 magazine in view of the Mast et al. patent. Claim 15 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Mast et al. patent in view of U.S. Patent No. 3,982,551 to Bartolucci and Claims 17 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the Mast et al. patent in view of U.S. Patent No. 4,450,848 to Ferrigno.

In response to the Office Action, Applicants respectfully traverse the rejection of Claims 1, 3-6, 8 and 10-13 on the basis of the Nail Max 2000 magazine. Applicants respectfully submit that the Nail Max 2000 magazine is not prior art to the claims of the present application under 35 U.S.C. § 102(a). In particular, the Nail Max 2000 magazine bears a publication date of December 15, 1999, which is less than one year before the present application's July 14, 2000 priority date and which is after the inventors made the claimed invention. In this regard, Applicants submit concurrently herewith a Declaration of Yong Jin Chang Under 37 C.F.R. §1.131 setting forth that the claimed invention was made in early 1999. Attached to Mr. Chang's Declaration as Exhibit A is a photograph showing certain embodiments of the claimed invention that were made at least as early as May 15, 1999. The embodiments depicted in the photograph are evidence of a reduction to practice of the claimed invention prior to the publication date of the Nail Max 2000 magazine. Accordingly, Applicants respectfully request withdrawal of the rejections based on the Nail Max 2000 magazine.

The elimination of the Nail Max 2000 magazine as a prior art reference leaves the Mast et al. patent as the primary prior art reference. In response to the prior art rejections based on the Mast et al. patent, Applicants have amended independent Claims 1, 8, 15 and 18 to define an artificial fingernail having a continuous opaque decoration comprising paint covering a substantial portion of the nail tip portion to give the appearance of a French

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manicure. It is respectfully submitted that none of the remaining prior art references, taken alone or combined, discloses an artificial fingernail having a transparent bed portion and a nail tip portion provided with a continuous opaque decoration comprising paint.

In particular, there is no mention in the Mast et al. patent of applying a paint to cover the nail tip portion of the artificial nail. Instead, the Mast et al. patent discloses a roughened or textured surface provided on the nail to give an opaque appearance to the nail tip portion. Thus, there is no teaching or suggestion in the Mast et al. patent of providing a continuous opaque decoration comprising paint to the tip portion of the nail. In this regard, it is noted that the Examiner did not reject original Claim 4, which included the opaque decoration comprising paint limitation, in view of the Mast et al. patent. Accordingly, it is respectfully submitted that independent Claims 1, 8, 15 and 18, as amended, and the Claims that depend therefrom patentably distinguish over the Mast et al. patent.

In view of the foregoing amendment and remarks, favorable consideration and allowance of the application with Claims 1-20 are respectfully solicited. If the Examiner believes that a telephone interview would assist in moving the application toward allowance, he is respectfully invited to contact the Applicants' attorney at the telephone number listed below.

On a separate note, pursuant to MPEP 2001.06(c), Applicants hereby bring to the attention of the United States Patent and Trademark Office the existence of a litigation involving the parent Application Serial No. 09/616,404, now U.S. Patent No. 6,354,304, of

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the present application. The litigation was commenced in the United States District Court for the Eastern District of New York under Case No. CV-02-2373. The parent U.S. Patent No. 6,354,304 is also the subject of Reexamination Control No. 95/000,023, filed July 17, 2003.

Respectfully submitted,



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